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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,938	09/29/2000	James E. McShane	FC0807Q1	1065

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SCHERING-PLOUGH CORPORATION  
PATENT DEPARTMENT (K-6-1, 1990)  
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EXAMINER

SHARAREH, SHAHNAM J

ART UNIT PAPER NUMBER

1617

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/675,938

Applicant(s)

MCSHANE, JAMES E.

Examiner

Shahnam Sharareh

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Amendment filed on November 14, 2003 has been entered. Claims 32-42 are now pending.

Applicant's arguments filed November 14, 2003 have been fully considered but they are not persuasive for the reasons described below. In addition, the new pending claims are now subject to new grounds of rejection under 35 USC § 112 2<sup>nd</sup>.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 32-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32 is directed to compositions consisting essentially of three elements (a), (b) and (c). However, the preceding claims further add additional components and employ the language "comprising" as the transitional language. Accordingly, the scopes of the pending claims are ambiguous because the dependent claims are broader than their original base claim.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakane US patent 5,122,418.

Art Unit: 1617

Applicant's arguments with respect to this rejection have been fully considered but are not found persuasive. Applicant first argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, Examiner points out that all elements of the instant claims are taught in Nakane as recited in previous Office Action. Further, the rejection merely considered the combination of the elements based on the knowledge of the ordinary skill in the art as provided by Nakane. Therefore, the conclusion was not based on improper hindsight rather prima facie obviousness.

Further, [O]bviousness does not require absolute predictability of success. *In re O'Farrell*, 7 USPQ2d 1673 (CAFC 1988). For obviousness under §103, all that is required is a reasonable expectation of success. *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985). Here, the mere mixing of the elements as taught by Nakane provides the required reasonable expectation of success. Thus, Nakane's teachings render the scope of the instant claims obvious.

Applicant's arguments as to the Examiner's reliance on the holding of *Sinclair & Carroll Co. v. Interchemical Corp*, 325 U.S. 327 (1945), have been fully considered but

Art Unit: 1617

are not found persuasive. Applicant argues that the ruling "is a case of notorious era in the history of patent law where the Supreme Court took a very anti-patent stance." (see Amendment at page 6). In response, Examiner states that *Sinclair* has not been yet overturned and is still competent law. Accordingly, Examiner's reliance on the factual and legal analysis is reasonable.

Furthermore, absence of showing clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. See MPEP 2111.03. In the instant case, even though the language of the generic claim uses the "consisting essential of" language, all other claims include additional components taught by Nakane. Therefore, as recited in the previous Office Action Nakane teaches compositions comprising micronized zinc oxide and a fragrance.

The amounts of zinc oxide used in Nakane falls within the ranges of the instantly claimed compositions (col 10, lines 48-61, examples 35-38). Nakane teaches the use of propellant as an aerosol deodorant spray in amounts of about 70-85% (example 31, 35, 36). Nakane's powder falls within the ranges of 1 to 100 microns wherein the zinc oxide particles have an average size of 0.01-10 microns, which is equal to 10-1000 nm (col 5, lines 38-41; col 10, lines 19-22). Nakane further teaches the use of water, C<sub>1</sub>-C<sub>3</sub> alcohols such as ethanol (col 10, lines 16-18; col 11, lines 42-44). Thus, mere combination of such parts for their own intended use would have been obvious as of record.

Art Unit: 1617

Claims 32-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lajoie US Patent 5,466,470 in view of Lisboa et al US Patent 5,679,324.

Applicant arguments have been fully considered but are not persuasive.

Applicant's essentially argues that Lisboa does not state some general desirability of formulations containing a propellant, but mentions aerosol having creams and shaving gels "gaining wide appeal among both men and women." In response, Examiner first disagrees with such interpretation. Before, Lisbo mentions the use of aerosol shaving creams and shaving gels, he acknowledges the employment of aerosolized compositions as a well-recognized practice in the art. See col 1, lines 7-18 of Lisboa where it states:

**Cosmetic aerosol foam compositions, particularly those used in association with shaving are well known in the art.**

Therefore, relying on such conventional mode of topical delivery systems, the rejection of record concluded that converting Lajoe's formulation, the primary reference, into an aerosolized delivery system would have been an obvious modification because there is ample motivation in the art to employ such delivery system. Applicant has not provided any evidence showing the contrary, thus, the rejection stands.

Moreover, in response to applicant's argument that the intended use of the instantly claimed composition is for foot and shoe odor, Examiner responds that the intended use for a topical composition does not impart patentability absence any structural difference. It has been well settled that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior

Art Unit: 1617

art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Here, there is motivation in the art to prepare the composition of Lajoie with a propellant. Thus, such composition would render the instant claims obvious even though the intended use may be different. Thus, the rejection is hereby maintained.

**Conclusion**

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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